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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,754	02/23/2004	Danny L. Mabey	60316/9	2222
7590 STOEL RIVES LLP One Utah Center Suite 1100 201 South Main Street Salt Lake City, UT 84111				
05/28/2008				
EXAMINER				
WONG, ALLEN C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,754

Applicant(s)

MABEY ET AL.

Examiner

Allen Wong

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 31-63 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 27 is/are allowed.
6) ☒ Claim(s) 1-24, 26, 28, 31-54 and 56-63 is/are rejected.
7) ☒ Claim(s) 25 and 55 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-28 and 31-63) in the reply filed on 4/9/08 is acknowledged.

This restriction is **FINAL**.

Information Disclosure Statement

2. The information disclosure statement filed 4/16/07 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

A copy of the foreign document EP 0889471 was not included during submission of IDS filed 4/16/07.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 28 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebler (6,356,589) in view of Puri (6,968,006).

Regarding claim 28, Gebler discloses a method for communicating a media signal (col.7, ln.36-40 and fig.5, note "video input stream") comprising:

the compression methods are automatically selected to produce a highest compression quality for the respective scenes according to a set of criteria without exceeding a target data rate (col.7, ln.55 to col.8, ln.5; Gebler discloses that processor 322 does the analysis for evaluating an association for each encoder 320, and that there can be multiple encoders or compression methods used, where each encoder has a unique number for identifying the specific encoder, col.4, ln.37-43, Gebler discloses using MPEG-2 encoding principles for achieving desirable, efficient, high quality encoding of image data at the optimal rate without exceeding constraints by applying recursive rate control scheme of MPEG-2 video encoding).

Gebler does not specifically disclose selectively compressing at least two scenes of a media signal using different compression methods available within a single codec, and delivering each compressed scene to a destination system with an indication of which compression method was used by the codec to compress each scene. However, Puri teaches selectively compressing at least two scenes of a media signal using different compression methods available within a single codec (col.3, ln.36-50, col.4, ln.59 to col.5, ln.6 and col.6, ln.33-49, Puri discloses the use of multiple encoders 906, 908, 910 and 912 to encode each scene with the appropriate CODEC or video encoder, see fig.9 and 13), and delivering each compressed scene to a destination system with an indication of which compression method was used by the codec to compress each scene (fig.9 and 13, note the CODEC(s) used in the encoder stage will report the CODEC(s) used to the decoder stage for decoding the video image data; col.6, ln.33-49 and col.18, ln.22-38). Therefore, it would have been obvious to one of ordinary skill in

the art to combine the teachings of Gebler and Puri, as a whole, for accurately efficient encoding, transmitting, receiving, decoding and displaying high quality image data (ie. movies, television shows, etc.), while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Regarding claim 60, Gebler discloses a codec for compressing a media signal comprising: the compression methods are automatically selected to produce a highest compression quality for the respective scenes according to a set of criteria without exceeding a target data rate (col.7, ln.55 to col.8, ln.5; Gebler discloses that processor 322 does the analysis for evaluating an association for each encoder 320, and that there can be multiple encoders or compression methods used, where each encoder has a unique number for identifying the specific encoder, col.4, ln.37-43, Gebler discloses using MPEG-2 encoding principles for achieving desirable, efficient, high quality encoding of image data at the optimal rate without exceeding constraints by applying recursive rate control scheme of MPEG-2 video encoding).

Gebler does not disclose a selection module for automatically selecting different compression methods to respectively compress at least two scenes of a media signal, and a compression module for compressing the scenes using the automatically-selected compression methods. However, Puri teaches the selection module for automatically selecting different compression methods to respectively compress at least two scenes of a media signal (col.3, ln.36-50, col.4, ln.59 to col.5, ln.6 and col.6, ln.33-49, Puri discloses the use of multiple encoders 906, 908, 910 and 912 to encode each scene with the appropriate CODEC or video encoder, see fig.9 and 13), and a

compression module for compressing the scenes using the automatically-selected compression methods (fig.9 and 13, note the CODEC(s) used in the encoder stage will report the CODEC(s) used to the decoder stage for decoding the video image data; col.6, ln.33-49 and col.18, ln.22-38). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Gebler and Puri, as a whole, for accurately efficient encoding, transmitting, receiving, decoding and displaying high quality image data (ie. movies, television shows, etc.), while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Regarding claim 61, Gebler does not specifically disclose wherein the selection module is to test at least a subset of the codecs concurrently using a plurality of separate processors. However, Puri teaches wherein the selection module is to test at least a subset of the codecs concurrently using a plurality of separate processors (col.3, ln.36-50, col.4, ln.59 to col.5, ln.6 and col.6, ln.33-49, Puri discloses the use of multiple encoders 906, 908, 910 and 912 to encode each scene with the appropriate CODEC or video encoder, see fig.9 and 13 by testing each encoder to determine the appropriate CODEC). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Gebler and Puri, as a whole, for accurately efficient encoding, transmitting, receiving, decoding and displaying high quality image data (ie. movies, television shows, etc.), while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Regarding claim 62, Gebler does not specifically disclose wherein the number of processors at least equals the number of methods to be tested. However, Puri teaches

the number of processors at least equals the number of methods to be tested (fig.9 and 13, note the CODEC(s) used in the encoder stage will report the CODEC(s) used to the decoder stage for decoding the video image data; col.6, ln.33-49 and col.18, ln.22-38, there are the same number of decoders for corresponding to the number of encoders). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Gebler and Puri, as a whole, for accurately efficient encoding, transmitting, receiving, decoding and displaying high quality image data (ie. movies, television shows, etc.), while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Regarding claim 63, Gebler does not specifically disclose wherein the selection module is to test each codec within a separate processing thread of a multiprocessing operating system. However, Puri teaches the selection module is to test each codec within a separate processing thread of a multiprocessing operating system (col.3, ln.36-50, col.4, ln.59 to col.5, ln.6 and col.6, ln.33-49, Puri discloses the use of multiple encoders 906, 908, 910 and 912 to encode each scene with the appropriate CODEC or video encoder, see fig.9 and 13 by testing each encoder to determine the appropriate CODEC). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Gebler and Puri, as a whole, for accurately efficient encoding, transmitting, receiving, decoding and displaying high quality image data (ie. movies, television shows, etc.), while robustly minimizing the requirements of encoding and decoding circuitry (Puri col.3, ln.39-45).

Allowable Subject Matter

1. Claim 27 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not disclose the combination of limitations as disclosed in claim 27: a media compression method comprising: providing a library of compression methods, at least one compression method having an associated licensing cost; obtaining a media signal to be communicated to a destination system; identifying a plurality of scenes within the media signal; automatically selecting different compression methods from the library to respectively compress at least two of the scenes, wherein the compression methods are automatically selected to produce a highest compression quality at the lowest licensing cost for the respective scenes according to a set of criteria without exceeding a target data rate; compressing the scenes using the automatically-selected compression methods; and delivering the compressed scenes to the destination system with an indication of which compression method was used to compress each scene.

4. Claims 25 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not specifically disclose wherein at least one compression method has an associated licensing cost, and wherein selecting further comprises automatically selecting the compression method having the least licensing cost in

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response to two or more compression methods producing substantially the same quality of compressed output for a scene, as disclosed in dependent claim 25 and 55, and would be patentable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-24, 26, 28, 31-54 and 56-63 are rejected on the ground of nonstatutory double patenting over claim 1 of U. S. Patent No. 7,295,608 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1, 26, 28, 31, 56 and 60 of the instant application is generic to all that is recited in claim 1 of US Patent No. 7,295,608. That is, claims 1, 26, 28, 31, 56 and 60 is anticipated by claim 1 of US Patent No. 7,295,608.

Claims 2-4, 32-34 of the instant application are disclosed in claim 10 of US Patent No. 7,295,608. That is, claims 2-4 and 32-34 are anticipated by claim 10 of US Patent No. 7,295,608. Claim 5, 20, 35 and 50 of the instant application is disclosed in claim 2 of US Patent No. 7,295,608. That is, claim 5, 20, 35 and 50 is anticipated by claim 2 of US Patent No. 7,295,608. Claim 6 and 36 of the instant application is disclosed in claim 6 of US Patent No. 7,295,608. That is, claim 6 and 36 is anticipated by claim 6 of US Patent No. 7,295,608. Claim 7 and 37 of the instant application is disclosed in claim 4 of US Patent No. 7,295,608. That is, claim 7 and 37 is anticipated by claim 4 of US Patent No. 7,295,608. Claims 8-9 and 38-39 of the instant application is disclosed in claim 5 of US Patent No. 7,295,608. That is, claim 8-9 and 38-39 is anticipated by claim 5 of US Patent No. 7,295,608. Claim 10 and 40 of the instant application is disclosed in claim 1 of US Patent No. 7,295,608. That is, claim 10 and 40 is anticipated by claim 1 of US Patent No. 7,295,608. Claim 11 and 41 of the instant application is disclosed in claim 7 of US Patent No. 7,295,608. That is, claim 11 and 41 is anticipated by claim 7 of US Patent No. 7,295,608. Claims 12-13 and 42-43 of the instant application is disclosed in claim 8 of US Patent No. 7,295,608. That is, claim 12-13 and 42-43 is anticipated by claim 8 of US Patent No. 7,295,608. Claim 14 and 44 of the instant application is disclosed in claim 3 of US Patent No. 7,295,608. That is, claim

14 and 44 is anticipated by claim 3 of US Patent No. 7,295,608. Claim 15-19, 45-49, 57-59 and 61-63 of the instant application is disclosed in claim 1 of US Patent No. 7,295,608. That is, claim 15-19, 45-49, 57-59 and 61-63 is anticipated by claim 1 of US Patent No. 7,295,608. Claim 21-22 and 51-52 of the instant application is disclosed in claim 12 of US Patent No. 7,295,608. That is, claim 21-22 and 51-52 is anticipated by claim 12 of US Patent No. 7,295,608. Claim 23-24 and 53-54 of the instant application is disclosed in claim 11 of US Patent No. 7,295,608. That is, claim 23-24 and 53-54 is anticipated by claim 11 of US Patent No. 7,295,608.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Wong whose telephone number is (571) 272-7341. The examiner can normally be reached on Mondays to Thursdays from 8am-6pm Flextime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Allen Wong/
Primary Examiner, Art Unit 2621

/Allen Wong/
Primary Examiner
Art Unit 2621

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